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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,929	01/29/2002	Uwe Heitmann	31976-177425	3754
26694	7590	12/02/2003	EXAMINER	
VENABLE, BAETJER, HOWARD AND CIVILETTI, LLP P.O. BOX 34385 WASHINGTON, DC 20043-9998			TAWFIK, SAMEH	
		ART UNIT	PAPER NUMBER	
		3721		

DATE MAILED: 12/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

CS

Office Action Summary	Application No.	Applicant(s)	
	10/057,929	HEITMANN, UWE	
	Examiner Sameh H. Tawfik	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 13 November 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) 15-20 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-14 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 29 January 2002 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(claim 1, lines 4 and 5) "...for compensating for departure of quantities of filter material from predetermined quantities." is vague, indefinite, and/or confusingly worded because it is not clear what applicant is referring to by "departure of quantities of filter material from predetermined quantities". Applicant needs to clarify the matter and needs to clearly point out to the invention's novelty and clarify how the compensating process done as descript in the personal interview on 11/6/2003.

Drawings

The drawings are objected to because in Fig. 1 (a-d), (e and f), and (g-I) need to be separated to clarify the invention as discussed in the interview on 11/6/2003. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, and 4-7 rejected under 35 U.S.C. 102(b) as being anticipated by Schubert (3,603,058).

Schubert discloses a machine for making filters for attachment to smokers products, a mobile transfer device (Fig. 2; via lever 39, ram 46, cam 47, and shaft 21) for introduction of filter material for tobacco smoke (Figs. 2 and 5; via hoppers 11 and 12) into sections of wrapping material (via tube 1); guide means (Fig. 2; via guide bores 24a and 28) for the transfer device; and compensating means between the transfer device and the guide means “for compensating for departure of quantities of filter material from predetermined quantities.”, see for example (Figs. 2-7).

Regarding claim 2: the guide means (Fig. 2; via guide bores 24a and 28) comprises a groove for a portion of one of the transfer device and the compensating means (Figs. 2-7).

Regarding claim 4: the transfer device (Fig. 2; via lever 39, ram 46, cam 47, and shaft 21) includes at least one mobile plunger (via ram 46 and/or shaft 21).

Regarding claim 5: the compensating means includes a tubular guide (Fig. 2; via bores bearings 23a, 23b, and/or bores 24) for the at least one plunger (via ram 46 and/or shaft 21).

Regarding claim 6: means for limiting the extent of movability of the plunger, see for example (Figs. 2-4; via hub 23).

Regarding claim 7: the compensating means comprises at least one spring (Figs. 2-7; via springs 44 and 52).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 8, 9, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schubert (3,603,058).

Schubert does not clearly disclose that the compensating means includes synthetic elastic material wherein the elastic material is a foam. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted Schubert's compensating means by having the compensating means includes synthetic elastic material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 14: Schubert discloses that the transfer device and the guide means has at least one chamber, see for example (Figs. 2-7).

Regarding claims 8 and 9: Schubert does not clearly disclose that a stepping motor for moving the plunger. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Schubert's apparatus by having that a stepping motor for moving the plunger, as a matter of engineering design choice, since the examiner takes an official notice that the mentioned motor is old, well known, and available in the art to use together with the mentioned apparatus.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schubert (3,603,058) in view of Millen et al. (4,724,429).

Schubert does not disclose that means for monitoring the extent of movability of the plunger wherein the monitoring means is selected from the group of power sensor, contact sensors, and distance sensors. However, Millen discloses that means for monitoring movement and adjustment parts of apparatus wherein the monitoring means is selected from the group of power sensor, contact sensors, and distance sensors, see for example (Figs. 1 and 2).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Schubert's apparatus by having monitoring means is selected from the group of power sensor, contact sensors, and distance sensors, as suggested by Millen, in order to detect whether a piece of equipment is not in its proper operating position and to control movement of different parts of the apparatus (column 4, lines 15-20).

Response to Arguments

Applicant's arguments filed on 11/13/2002 have been fully considered but they are not persuasive.

Applicant argue in pages 7 and 8 of the arguments that Schubert's reference does not disclose the claimed compensating means to enables a longer than normal or longer than anticipated movement of the transfer device 17 when the quantity of filter material in the tube is less than required, and also enables the transfer device 17 to perform a shorter than normal or shorter than anticipated movement when the quantity of filter material in the tube exceeds the optimum quantity. The examiner believes that the applicant is arguing about something not disclosed in the claim. Note that what applicant is arguing about was discussed in the interview

dated on 11/6/2003 and applicant was suppose to amend claim 1 in order to disclose what is been arguing about and to clarify the claim and point out to the novelty of the claim by clarifying what exactly meant by “compensating” as it is desried in the arguments.

Applicant further argue in page 8 of the arguments that Schubert’s reference neither appreciates nor recognizes an advantage of such a compensating means. The examiner believes as set forth “compensating” as claimed in claim 1 is very broad and not describing the novelty of the invention.

Applicant also argue in page 8 that Schubert states “each of a succession of filter tips contains the same quantity of granular filter material and...the space occupied by such granular material in each of a series of successively produced filter tips is the same.”, Schubert does not account for or consider that a less than optimum amount of tobacco material could be delivered. The examiner agrees with the applicant that Schubert does not account for or consider that a less than optimum amount of tobacco material could be delivered, but the examiner believes that what applicant is arguing abut need to be in the claim language. The applicant needs to amend claim one in order to point out exactly to how the compensating done and what does it mean in the apparatus.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sameh H. Tawfik whose telephone number is (703) 308-2809. The examiner can normally be reached on Tuesday - Friday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (703) 308-2187. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

ST.



Mickey Yu
Supervisory Patent Examiner
Group 3700